

This Office action has been made to clarify a typo, with regard to box 7 on form PTO-303, in the prior Advisory Action. It is noted that previously, the prior amendment was stamped by the Office as "OK to Enter". As such, the position taken by the Office has remained unchanged.

Response to Amendment

The amendment to the claims removes the objection to claims 1-4 and 7-10 and has thus been entered. However, the proposed amendment does not affect the scope of the claims as the proposed amendment is in line with the previous interpretation of the claims. The claims would be rejected in the same manner as in the previous action.

Response to Arguments

Applicant's arguments filed May 15, 2008 have been fully considered but they are not persuasive, because:

A) Applicant's argument that Moren et al. only discloses using the catalysts in a narrow reaction is not persuasive. Irie et al. teaches using a tertiary phosphine as the catalyst for the Michael reaction (4:25-43). Therefore a person having ordinary skill in the art at the time of invention would have been motivated to look at art relating to the use of tertiary phosphine catalysts in Michael reaction systems. Despite the fact that Moren et al. does not disclose using the tertiary alkyl phosphine in the specific reaction system of Irie et al., a person having ordinary skill in the art at the time of invention would have found it to be obvious to try using the tertiary alkyl phosphine catalyst of Moren et al. in the composition of Irie et al.

B) Applicant's argument of unexpected results is not persuasive. In order to show the unexpected result of an invention, one must show that the invention was in fact unexpected, not just superior. See MPEP 716.02. Applicant has merely shown that the use of a trialkylphosphine and an acid provide desirable results in the cited tables. The lack of any comparative examples or trends preclude the cited tables from showing an unexpected result.

Terminal Disclaimer

The terminal disclaimer filed on May 15, 2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,897,264 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Liam J. Heincer whose telephone number is 571-270-3297. The examiner can normally be reached on Monday thru Friday 7:30 to 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MARK EASHOO, PhD./

Supervisory Patent Examiner, Art Unit 1796

17-Jul-08

LJH

July 15, 2008